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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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GOLD

99-50283

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EXAMINER

1054

ART UNIT

PAPER NUMBER

1545

DATE MAILED:

15
12/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/130,887

Applicant(s)

Gold

Examiner
LI Lee

Group Art Unit
1645



☒ Responsive to communication(s) filed on Sep 29, 1900

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-20 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

Continued Prosecution Application

1. The request filed on Sep 29, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/130,887 is acceptable and a CPA has been established. An action on the CPA follows.

The Preliminary Amendment filed on Sep 29, 2000 has been received and entered. Consequently claims 1-20 are pending the instant application.

2. Applicant's arguments with respect to the restriction requirement imposed in the Office action dated May 15, 2000 have been considered and the restriction requirement is withdrawn in view of applicant's remarks. However, upon further consideration, a new restriction requirement is set forth below.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-3, drawn to a composition comprising a non-binding FK 506 analog, classified in class 514, subclass 1.
 - II. Claims 4-5, drawn to a method of stimulating nerve cell growth, classified in class 514, subclass 150.
 - III. Claims 6-18 and 20, drawn to a method of identifying a non-binding FK 506 analog, classified in class 435, subclass 7.1.

6-20 pending

Art Unit: 1645

IV. Claims 19, drawn to a method of identifying a non-binding FK 506 analog comprising administering the analogs to a patient at the recited dosage, classified in class 424, subclass 9.1.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product, e.g. other known neuron growth factors.

Inventions II-IV are drawn to independent and distinct methods which differ in the method objectives, method steps, in the reagents used, and have different final outcomes.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by the different classification, and absent restriction would place an undue search and examination burden on the examiner, therefore restriction for examination purposes as indicated is proper.

5. This application contains claims directed to patentably distinct species of the claimed invention. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. The disclosed species cited in pages 6-16 of the specification and in claim 13 are different and independent in that they are structurally dissimilar and distinct. The search required for one species is not required for another.

Art Unit: 1645

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.


Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li Lee whose telephone number is (703) 308-8891. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached at (703) 308-3909.

Li Lee
December 14, 2000


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600